

## REMARKS

### The Objection to the Drawings

Replacement drawings are attached herewith. Withdrawal of the objection to the drawings is requested.

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### The Section 102 Rejection

The Office Action of January 16, 2004 withdrew the Section 103 rejection for claims 1-11 and applied a Section 102 rejection using Fredlund (USPN 5,666,215). All other claims that relied on Johnson (USPN 6,052,670) were rejected using Fredlund. The

10 Office Action noted that

Regarding claim 1, Fredlund discloses a method of distributing image prints printed on a plurality of printers to a plurality of recipients, the method comprising:

15 Receiving an order specifying one or more recipients and, for each specified recipient, a set of one or more images associated with that recipient (column 5, lines 38-47; column 6, lines 21-41); and

for each recipient specified by the order, separating the images associated with the recipient into at least one printable unit of images (column 7, lines 18-30 and column 2, lines 42-44).

20 Fredlund discloses in column 2, lines 37- 40 that customer orders desired prints and services and designates a recipient. Since the claim calls for one or more recipient, the cited paragraph meets the claim limitation for one recipient. Fredlund also discloses in column 6, lines 29-41 when order for a particular images are placed customer actuates the "done" button and can proceed to place another order which can be for another recipient. When customer has completed placing orders customer  
25 actuates the "place order" button, which advances to payment screen. "This facilitates sending the same image to different addresses (or different recipients) in screen 68 without re-editing the image." Since Fredlund teaches more than one recipient address, it suggests more than one recipient. Therefore Fredlund can meet the claim limitation for one or more recipients.

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Applicants respectfully traverse the rejection. Fredlund relates to a system for remotely selecting photographic images where a photographic image can be viewed at a customer's location on her personal computer and images selected for initial printing,

reprinting and ordering related image services. Photographic negatives are provided to a scanner to obtain image data. The image data is manipulated to provide a positive image of the photographic negatives and sent to the customer's personal computer. The desired prints are then selected and order information is provided, based on the positive image as displayed on the display of the personal computer. The order information is recorded to allow the desired prints and services to be created and the resulting order is sent to a designated addressee.

A Section 102 rejection requires each and every element to be present. Here, Fredlund fails to show a number of elements. First, Fredlund fails to show receiving an order specifying a plurality of recipients and, for each specified recipient, a set of one or more images associated with that recipient.

Moreover, another independent basis for traversing the rejection is that Fredlund fails to show separating the images associated with the recipient into at least one printable unit of images to generate a contiguous run of prints for each recipient specified by the order.

Since at least two elements are not shown in Fredlund, the Section 102 rejection of independent claim 1 is improper and should be withdrawn. Moreover, claims that depend therefrom are not anticipated by Fredlund.

With respect to claim 35, Fredlund does not show receiving an order specifying one or more a plurality of recipients and, for each specified recipient, a set of digital content associated with that recipient; for each recipient specified by the order, separating the digital content associated with the recipient into at least one generatable unit of digital content having a contiguous run of prints for the recipient; and for each generatable unit of digital content, generating a physical manifestation of the unit of digital content..

Fredlund's Col. 5, lines 35-51 does not show the scheduler but teaches that:

If there are more images in the file than can be shown in the column 52, the other images can be displayed by activating a scroll bar 54 to scroll the images in the column. To select one of the images from the digital image file, the customer selects the desired print size and quantity in area 76. Display area 56 assumes the correct aspect ratio for the desired final print size. The customer then

identifies one of the images using a standard drag and drop computer interface or set-top box selection mode, for example by clicking on one of the images with a mouse or trackball and dragging it into the large display area 56, or by entering the desired frame number on a remote control device if the program is implemented via a set-top box. The customer can thereby use the computer data entry means to select one at a time the images he or she desires to have printed and desired services relating to each selected image. In this manner, a simple, non-intimidating display can be used to enter all necessary order information. Other image related services may include Photo CD's, image bearing items such as coffee mugs and T-shirts, and poster sized prints.

Here, Fredlund does not show a number of elements recited in claim 35 and thus cannot render claim 35 obvious. Allowance of claim 35 and those dependent therefrom is requested.

Similarly, independent claim 43 and those dependent therefrom are also patentable over Fredlund. Withdrawal of the Section 102 rejection is requested.

#### The Section 103 Rejection

Claims 12-14, 29-31, 33, 59-76 and 89 were rejected under Section 103(a) as unpatentable over Fredlund and Cok (6,157,436). Cok relates to an image printing system for generating multiple printed image copies in response to an order. A processor can divide the order into multiple sub-orders for respective image printers, each sub-order having a sub-order header which includes a unique order identification and an indication of the number of copies of the image to be printed by the corresponding printer. A plurality of image printers are connected to the processor, to each receive a corresponding sub-order and print the corresponding sub-order header, and the numbers of image copies indicated in that header.

Applicant notes that the present rejection does not establish *prima facie* obviousness under 35 U.S.C. § 103 and M.P.E.P. §§ 2142-2143. The Examiner bears the initial burden to establish and support *prima facie* obviousness. *In re Rinehart*, 189 U.S.P.Q. 143 (CCPA 1976). To establish *prima facie* obviousness, three basic criteria must be met. M.P.E.P. § 2142. First, the Examiner must show some suggestion or

motivation, either in the Johnson et al. reference or in the knowledge generally available to one of ordinary skill in the art, to modify the reference Fredlund so as to produce the claimed invention. M.P.E.P. § 2143.01; *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Secondly, the Examiner must establish that there is a reasonable expectation of success  
5 for the modification. M.P.E.P. § 2142. Thirdly, the Examiner must establish that the prior art references teach or suggest all the claim limitations. M.P.E.P. §2143.03; *In re Royka*, 180 U.S.P.Q. 580 (CCPA 1974). The teachings, suggestions, and reasonable expectations of success must be found in the prior art, rather than in Applicant's disclosure. *In re Vaeck*, 20 U.S.P.Q.2d 1438 (CAFC 1991). Applicant respectfully  
10 submits that a *prima facie* case of obviousness has not been met because the Examiner's rejection fails on at least two of the above requirements.

Applicant traverses the comparison. Here, there is no suggestion or motivation in Fredlund to use Cok to arrive at a computer-implemented method of distributing image prints to a plurality of recipients by receiving an order specifying a plurality of recipients  
15 and, for each specified recipient, a set of one or more images associated with that recipient; for each of the plurality of recipients specified in the received order, printing at least one copy of each image in the recipient's image set; and distributing the printed image copies to their respective associated recipient.

Applicant points out that the Examiner bears the initial burden of factually  
20 establishing and supporting any *prima facie* conclusion of obviousness. *In re Rinehart*, 189 U.S.P.Q. 143 (CCPA 1976); M.P.E.P. § 2142. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of nonobviousness. *Id.* In the instant case, the Examiner has not pointed to any evidence in Johnson or how knowledge of those skilled in the art, provide a suggestion or motivation  
25 to modify the reference teaching so as to produce the claimed invention of claim 1 of a single order with multiple recipients. See *In re Zurko*, 59 U.S.P.Q.2d 1693 (Fed. Cir. 2001) ([I]n a determination of patentability .... the Board cannot simply reach conclusions based on its understanding or experience - or on its assessment of what

would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings).

Under *Vaeck*, absent any evidence of a cited suggestion or reasonable motivation in the Johnson reference, or knowledge of those skilled in the art, for a single order  
5 specifying a plurality of recipients, *prima facie* obviousness of claim 1 (and dependent claims) has not been established. As such, it is respectfully requested that the § 103(a) rejection of independent claims (and dependent claims) be withdrawn and the claims be allowed.

Here, neither Fredlund nor Cok show the missing elements of the independent  
10 claims raised above, namely a method of distributing image prints printed on a plurality of printers to a plurality of recipients, the method comprising: receiving an order specifying a plurality of recipients and, for each specified recipient, a set of one or more images associated with that recipient; and for each recipient specified by the order, separating the images associated with the recipient into at least one printable unit of  
15 images to generate a contiguous run of prints for the recipient.

Hence, Fredlund, Cok, Shaked, Chan, Gringeri, Zorn, Juan, Church and Robertson, singly or in combination, cannot render the independent claims obvious. With respect to the dependent claims, they are allowable because they depend from allowable independent claims.

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#### CONCLUSION

Applicants believe that the above discussion is fully responsive to all grounds of rejection set for the in the Office Action.

If for any reasons the Examiner believes a telephone conference would in any  
25 way expedite resolution of the issues raised in this appeal, the Examiner is invited to telephone the undersigned at 408-528-7490.

Respectfully submitted,



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